

### **REMARKS**

Claims 3-16 and 18-33 are pending. Claims 25 and 27-31 stand withdrawn from consideration. Claims 3-16, 18-24, 26, 32, and 33 stand rejected. Applicant thanks the Examiner for withdrawing the rejections under 35 U.S.C. § 102 and the rejections under 35 U.S.C. § 103 based on United States patent no. 5,643,197 as discussed during the telephonic interview on November 23, 2009.

Claims 32 and 33 are amended. Support for the amendments can be found, *inter alia*, in paragraph [0077] of the specification and in Figures 7-9.<sup>1</sup> No new matter is introduced.

Applicant has reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicant submits that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

### **Rejections Under 35 U.S.C. § 103**

#### **Claims 3-16, 18, 26, and 33**

The Examiner rejects claims 3-16, 18, 26, and 33 under 35 U.S.C. § 103 as obvious over United States patent no. 6,837,886 ("Collins"). Applicant respectfully disagrees.

Though the prior art references need not teach or suggest each and every limitation of a claim for that claim to be obvious, Applicant contends that the differences between the rejected claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. MPEP § 2141 ("[T]he focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and *on what such a person would have reasonably expected to have been able to do in view of that knowledge.*") (emphasis added). In particular, as discussed in further detail below, Applicant respectfully submits that one of

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<sup>1</sup> Paragraph references are to the application as published. United States patent application publication no. 2004/0143256 (Jul. 22, 2004).

ordinary skill in the art would not have learned the claimed invention from the asserted references, at least because the asserted references do not teach or suggest each and every element of the claimed invention.

Claim 26 recites, *inter alia*, that “the fixed braided electrode means . . . extends around less than about 180 degrees of a circumference of the catheter shaft means.” As amended, claim 33 similarly recites “at least one braided electrode having an outer periphery sandwiched between the inner tubular structure and the outer tubular structure[.]” This is illustrated, for example, in Figures 7-9.

Collins, on the other hand, teaches a radially expandable braided conductive member (28) that extends *all the way around* an inner member (22). See Collins, 4:65-5:14. That is, though shrouds may be used to cover certain portions of Collins’s conductive member (see, e.g., Collins, Figs. 20A-20E), the braided member itself extends *beyond* 180 degrees, and in fact extends 360 degrees, about the circumference of Collins’s catheter. The “outer periphery” of Collins’s conductive member is not between inner and outer tubular structures, but rather “anchored at respective ends 30 and 32 to the first sheath 24 and the second sheath 26, respectively.” Collins, 5:1-3. Thus, Collins neither teaches nor suggests each and every aspect of the present invention.

Moreover, modifying Collins’s conductive member to “extend around less than about 180 degrees of a circumference” of Collins’s catheter, as recited in claim 26, or such that the outer periphery of Collins’s conductive member is “sandwiched between the inner tubular structure and the outer tubular structure” as recited in claim 33 would render Collins unsatisfactory for its intended purpose and/or change Collins’s principle of operation. Specifically, Collins’s conductive member, so modified, could not radially expand in order to contact tissue to be treated or diagnosed. See Collins, 15:13-15, 16:12-20, and Figs. 22 and 24.

For at least the foregoing reasons, Applicant respectfully submits that Collins does not render claim 26 or claim 33 *prima facie* obvious. See MPEP §§ 2143.01(V) (“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification.”) and (VI) (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”) (citations omitted). Claims 3-16 and 18, which depend from claim 33, are *ipso facto* non-obvious over Collins. See *id.* § 2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.”) (citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Reconsideration and withdrawal of the rejection of claims 3-16, 18, 26, and 33 is respectfully requested.

#### Claims 19-23

The Examiner rejects claims 19-23 under 35 U.S.C. § 103 as obvious over Collins in view of United States patent no. 6,120,500 (“Bednarek”). Applicants respectfully disagree.

Claims 19-23 depend from claim 33. The shortcomings of Collins with respect to claim 33 are discussed at length above and are not cured by the addition of Bednarek. Indeed, the Examiner relies on Bednarek only for its teaching of a control wire. Office action, p.3. It follows that claims 19-23 are substantially different from, and therefore non-obvious over, the combination of Collins and Bednarek. Applicant accordingly respectfully requests reconsideration and withdrawal of the rejection of claims 19-23 under 35 U.S.C. § 103.

#### Claim 24

The Examiner rejects claim 24 under 35 U.S.C. § 103 as obvious over Collins in view of Bednarek and United States patent no. 6,080,151 (“Swartz”). Applicants respectfully disagree.

Claim 24 depends from claim 23. The shortcomings of Collins and Bednarek with respect to claim 23, discussed at length above, are not cured by the addition of Swartz. Indeed, the Examiner relies on Swartz only for its teaching of “provid[ing] electrode leads through a second lumen to keep the wires separate from the fluid delivery lumen.” Office action, p.4. It follows that claim 24 is substantially different

from, and therefore non-obvious over, the combination of Collins, Bednarek, and Swartz.

Claim 32

The Examiner rejects claim 32 under 35 U.S.C. § 103 as obvious over Collins in view of United States patent no. 6,078,830 ("Levin"). Applicants respectfully disagree.

As amended, claim 32 recites that "a radius from any point on the at least one braided electrode to a central axis of the inner tubular structure is constant." That is, because of the "fixed position" of the electrode between the inner and outer tubular structures of the catheter shaft, the electrode does not radially expand and/or contract, relative to the catheter body, even though the overall shape of the catheter body may change. Advantageously, this configuration facilitates pressing the electrode against tissue to be ablated. See, e.g., Specification ¶ [0076].

As discussed above in connection with claims 26 and 33, Collins requires that the conductive member be radially expandable. See, e.g., Collins, 5:4-17 and Figs. 22 and 24. Collins therefore teaches away from the present invention. It follows that claim 32 is substantially different from, and therefore non-obvious over, the combination of Collins and Levin. Reconsideration and withdrawal of the rejection of claim 32 is respectfully requested.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

Applicant submits that no extension of time is necessary for this paper to be considered timely. Should any extension of time be deemed necessary, Applicant hereby petitions therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0B-044401US/82410-0053.

Respectfully submitted,

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